

REMARKS

Please note that in the Reply filed November 28, 2006, the phrase “indicating to the user the outcome of the processing of the one or more free-form annotations” was inadvertently inserted after Claim 20. Please disregard this text.

The following Remarks are in reply to the Office Action mailed February 20, 2007. Claims 1-61 were pending in the Application prior to the outstanding Office Action.

Claims 1, 15, 20, 41, 60 and 61 have been amended. The amendments to Claims 1, 20, 41, 60 and 61 introduce limitations supported in the specification at least at paragraphs [0014], [0016], [0019]-[0024], [0030] and [0032]-[0034]. Claims 1-61 remain for the Examiner's consideration. Reconsideration and withdrawal of the rejections are respectfully requested.

CLAIM OBJECTIONS

The Examiner objects to the word ‘and’ in Claim 15.

The Applicant thanks the Examiner for her careful reading of the claim and amends the claim as suggested by the Examiner.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 1-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant thanks the Examiner for her careful reading of Claim 1. The Applicant has amended Claim 1 to include three additional steps to help particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 112 rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-61 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable Marshall, U.S. Patent App. No. 2003/0070139 (hereinafter ‘*Marshall*’), in view of Bargerion, U.S. Publication No. US 2004/0252888 (hereinafter ‘*Bargerion*’).

Claim 1

Claim 1 has been amended with three additional limitations “(c) selecting a first categorized annotation type where the first categorized annotation type is an anchor type” and “(d) selecting a second categorized annotation type where the second categorized annotation type is selected from the group consisting of anchor type and comment type” and “(e) selecting another categorized annotation type where the categorized annotation type is selected from the group consisting of anchor type, comment type and connector type”. Since *Marshall* and *Barger* do not teach or suggest any of these limitations Claim 1 was not obvious at the time the invention was made.

Claims 20, 41, 60 and 61

The Examiner states that *Marshall* does not disclose, but that

“*Barger* discloses generating a logical anchor for each annotation - generating one or more categorized annotations of the one or more free form annotations based on one or more of anchor types, comment types and connector types where the anchor types, comment types and connector types are selected from a predetermined set of anchor types, comment types and connector types ([0017], [0062], [0075]: generating annotations of anchor type where the anchor type is one of the types of the classified annotations)”. (February 20, 2007 office action, page 4, pt 9, second full paragraph).

Meaning of Predetermined

The Applicant respectfully disagrees that *Barger* teaches or suggests in the paragraph indicated above or otherwise the limitations implicit in the word ‘predetermined’ when used in the phrase ‘categorized annotations based on anchor types are selected from a predetermined set of anchor types’. The word ‘predetermined’ is defined as: to determine, decide, or establish in advance (see <http://www.thefreedictionary.com/predetermined> last visited March 5, 2007). Based on this definition, the use of ‘predetermined’ in the phrase ‘categorized annotations based on anchor types being selected from a predetermined set of anchor types’ implies (i) a ‘time limitation’ and (ii) a choice limitation.

Time Limitation of Predetermined

Significantly, *Barger* indicates that user input participates in the classification “[t]he user may use the feedback user interface 280 to modify how the anchoring module 210 generates logical anchors for annotation,...”; “[t]he user may use the feedback user interface 280 to

manually specify which set of rules the reflow module 250 should use when reflowing a particular annotation, for instance if the default set of reflow rules for the annotation's type are incorrect considering the annotation's particular characteristics” and “[f]inally, the user may use the feedback user interface 280 to manually specify which set of rules the clean-up module 260 should use when displaying a formalized or "cleaned-up" version of an annotation, for instance if the default set of "clean-up" rules for the annotation's type is incorrect given the annotation's particular characteristics” (*Barger*, paragraph [0062]). In contrast to *Barger*, the Applicant’s invention classifies each notation at creation time, not at ‘*Barger*’s’ reflow time. *Barger* collects a group of strokes and attempts to classify them as a whole, rather than classifying each stroke as it is collected. The Applicant’s invention does not require user input. Thus, the user input required in *Barger*’s method, is significantly different from the Applicant’s invention. Thus, *Barger* does not teach or suggest the ‘time limitation’ implied by predetermined, i.e., that the type of mark is annotated ‘in advance’.

Choice Limitation of Predetermined

Further, the Applicant disputes that *Barger* teaches or suggests in the paragraph indicated above or otherwise the ‘choice limitation’ implicit in the word ‘predetermined’. In paragraph [0019], the Applicant defined “[a]nchors, which include: highlights, underlines, margin bars, circled words, circled areas, brackets, etc”. In contrast, *Barger* makes clear in paragraph [0017] that the annotation must be logically anchored to a region or position in the document where it belongs such that the same region or position in the document can be recovered even if the document’s layout, format or content changes”. Paragraph [0072] underscores this interpretation, “[a]nchoring the annotation insures that the annotation will be placed in the correct region of the document even after the document is modified”. As such, *Barger* appears to be describing an anchor as a method of linking annotation symbols rather than as an annotation symbol per se. In contrast, the Applicant determines stroke types based on a mode (as determined by previously-classified strokes), rather than inferring a type from the set of strokes considered all at the same time. Further, the Applicant’s invention constrains the types of succeeding strokes based on classifying preceding strokes. As each mark is classified, it constrains the possible types of the next mark. Thus, *Barger* does not teach or suggest the ‘choice limitation’ implied by predetermined, i.e., that the type of mark is determined ‘in advance’.

Neither *Marshall* nor *Barger* teach or suggest “generating one or more categorized annotations of the one or more free form annotations based on one or more of anchor types, comment types and connector types where the anchor types, comment types and connector types are selected from a predetermined set of anchor types, comment types and connector types”. As such, Claims 20, 41, 60 and 61 were not obvious at the time the invention was made.

Teaching Away

Further, *Barger* teaches away from the claimed invention in as much as *Barger* proposes a ‘pruning’ limitation is placed on grouping and classification of annotation symbols such that “only groups of strokes that are proximate to one another in time and/or space are considered as part of the grouping and classification module's 310 dynamic program” (*Barger*, paragraph [0065]). Since a ‘pruning’ limitation is contrary to selecting from a predetermined set of anchor types, comment types and connector types, *Barger* teaches away from the claimed invention. MPEP 2145.03 III.

Claims 10, 17, 31, 38, 50 and 57

The Examiner indicates “[r]egarding Claim 10, which is dependent on claim 1, *Marshall* disclosing reserving an area on the screen for the input of the one or more freeform annotations ([0040])” and “[r]egarding Claim 17, which is dependent on claim 12, *Marshall* discloses: reserving an area on the screen for the rendering of the comment ([0040] writing marginalia implies that margin is reserved as an area to render a comment)”. However, paragraph [0040] states

“Finally patterns of marking can be used to help assess relative value. For example, passages associated with more than one type of mark can be identified. In FIG. 3, it is possible to detect the circle, the arrows, and the fact that there is a marginal note adjacent to these symbols. The confluence of these factors, i.e., that the reader circled the text rather than underlined it; that the reader marked it with symbols on both sides; and that the reader wrote marginalia, allow a determination to be made that the reader thought that the passage in the text is particularly important”.

Claims 31, 38, 50 and 57 were rejected under the same rationale (February 20, 2007 office action, page 10, first paragraph – fourth paragraph). The Applicant respectfully requests that the Examiner explain why writing in the margin teaches or suggests ‘reserving an area’ to render an annotation or comment.

Claims 12, 33 and 52

The Examiner indicates “[r]egarding Claim 12, ... - a link capable of connecting two anchors – a comment capable of associating with either an anchor or a connector”. However, the Examiner does not specify where either *Marshall* or *Barger* teach or suggest either limitation. Claims 33 and 52 were rejected under the same rationale (February 20, 2007 office action, page 10, first paragraph – fourth paragraph). “In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application”. MPEP 707.07(f). Therefore, the Examiner is requested to fully explain, the basis for stating that Marshall discloses these limitations or otherwise to reconsider the ground for the rejection.

Claims 16, 37 and 56

The Examiner indicates “[r]egarding Claim 16, ... - resizing and/or splitting the annotation mark – repositioning the annotation mark on the portion of the digital document under display”. However, the Examiner does not specify where either Marshall or Barger teach or suggest either limitation. Claims 37 and 56 were rejected under the same rationale (February 20, 2007 office action, page 10, first paragraph – fourth paragraph). “In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application”. MPEP 707.07(f). Therefore, the Examiner is requested to fully explain, the basis for stating that Marshall discloses these limitations or otherwise to reconsider the ground for the rejection.

Claims 2-19, 21-40 and 42-59 all directly or indirectly depend from independent Claims 1, 20 and 41, and are therefore believed patentable for at least the same reasons as independent Claims 1, 20 and 41 and because of the additional limitations of these claims.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejection.

Additional Basis for Patentability

The Applicant believes that the Examiner has not considered both the time limitation and the choice limitation implicit in the 'predetermined' limitation and as a consequence incorrectly found that *Marshall* teaches or discloses the limitation "processing the one or more freeform annotations based on the one or more categorized annotations via a completely deterministic state machine". Because *Marshall* and *Barger* do not teach or disclose "processing the one or more freeform annotations based on the one or more categorized annotations via a completely deterministic state machine" the claims were not obvious at the time the invention was made.

CONCLUSION

In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge the required fees and any underpayment of fees or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: May 8, 2007

By: /Anthony G. Craig/
Anthony G. Craig
Reg. No. 50,342

FLIESLER MEYER LLP
650 California Street, 14th Floor
San Francisco, CA 94108
Telephone: (415) 362-3800
Facsimile: (415) 362-2928
Customer No. 23910
officeactions@fdml.com